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UNITED STATES PATENT & TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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MAR 1 4 2001

Office of the Director
Group 3600

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Paper No. 24

In re Application of	:	
William P. Newton et al	:	
Application No. 08/839,161	:	DECISION ON PETITION
Filed: April 22, 1997	:	REGARDING HOLDING OF
Attorney Docket No.:	:	NON-COMPLIANCE OF
For: SUPPORT SYSTEM FOR LATERALLY REMOVABLE SASH	:	APPEAL BRIEF UNDER 37 CFR 1.181

This is in response to applicants' petition under 37 CFR 1.181 filed July 26, 2000 requesting withdrawal of the holding of non-compliance of the appeal brief with the requirements of 37 CFR 1.192(c) mailed June 12, 2000. The delay in answering this petition is regretted.

The Petition is **DENIED**.

Applicants allege that the examiner's holding that the appeal brief filed April 17, 2000 is not in compliance with the requirements of 37 CFR 1.192(c) is improper. In particular, it is applicants' position that there is no requirement for each claim stated to stand or fall separately to be argued separately.

37 CFR 1.192(c)(7) and MPEP 1206 set forth that for each ground of rejection applied to a group of two or more claims, the Board shall select a single claim from the group to decide the appeal as to the ground of rejection on the basis of that claim alone *unless* applicants include a statement that the claims of the group do not stand or fall together *and*, in the argument under 37 CFR 1.192(c)(8), applicants explain why the claims of the group are believed to be separately patentable. Further, merely pointing out the differences in what the claims cover is not an argument as to why the claims are separately patentable.

A review of the record reveals that the appeal brief filed on April 17, 2000 contains a statement that the claims of the different groups do not stand or fall together. See item 7, titled "Grouping of Claims", on page 5 of the brief. However, the appeal brief fails to explain why each of the claims are separately patentable with regard to the respective ground of rejection. See item 8, titled "Argument", beginning on page 5 of the brief.

As one example of this deficiency, claims 1-11, 29, 30, 32-34, 39-44, 46-48, 53-58, 60-63, and 67-73 are rejected under 35 U.S.C. § 102(b) as being anticipated by Haas. In accordance with the statement on page 5 of the brief, all of these claims are said to stand or fall separately. In order for the separate patentability of these claims to be considered, applicants must also explain in the argument why each of the claims are separately patentable. However, review of the arguments on pages 5-12 pertaining to this ground of rejection reveals that applicants have failed to explain why each of claims 3, 5, 6, 8, 9, 10, 11, 33, 34, 48, 54, 55, 56, 57, 58, 60, 62, 63, 71, and 72 are separately patentable.

It is quite clear that 37 CFR 1.192(c)(7) requires two affirmative acts in the brief in order to have separate patentability of a plurality of claims subject to the same rejection considered. Applicants must (1) state which claims do not stand or fall together *and* (2) present arguments why the claims subject to the same ground of rejection are separately patentable. Where an applicant does neither, it is appropriate for the examiner and the Board to rely upon the presumption created by the words of the rule and treat all claims as standing or falling together. However, where an applicant (1) omits the statement required by 37 CFR 1.192(c)(7) yet presents separate arguments in the "Argument" section of the brief or (2) includes the statement required by 37 CFR 1.192(c)(7) that the claims do not stand or fall together yet does not offer separate arguments in support in the "Argument" section of the brief, an inconsistency is present that evidences non-compliance with 37 CFR 1.192(c).

Applicants' assert that 37 CFR 1.192(c) does not require a separate argument for each claim of a rejected group. This assertion is correct only in the instance where the non-argued claim is not stated to stand or fall separately. The Rule requires a separate argument for each claim stated to stand or fall separately as has been pointed out above. In view of the fact that applicants stated that each claim was to stand or fall separately, a separate argument for each claim was required in order for the brief to be in compliance. Because applicants' brief contained a clear inconsistency between which claims were stated to stand or fall separately and which claims were separately argued, the brief is clearly in non-compliance with 37 CFR 1.192(c).

It appears that it is applicants' belief that the Rule only requires a parroted blanket statement under the heading "Grouping of Claims" that the claims do not stand or fall together without having to actually identify those claims which are considered to stand or fall separately. However, this is incorrect. 37 CFR 1.192(c)(7) requires an applicant to identify those claims considered to stand or fall separately. Further, there must be agreement between the claims which have been stated to not stand or fall together and the claims actually argued separately.

It is noted that the period for response set forth in the Notification of Non-Compliance, and any possible extensions thereof, has expired. Accordingly, *if* no timely response thereto has already been filed, the appeal in this application will be dismissed and the application held abandoned. Applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the response was unavoidable. This includes a satisfactory showing that the cause of delay resulting in failure to respond in timely fashion to the Office communication was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(m); and **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.

The small entity petition fee required by law for filing a petition under the unavoidable standard is $55. The fee for a petition under the unintentional standard is $620.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By fax: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza 4, Suite 3C23
2201 South Clarke Place
Arlington, VA 22202

Telephone inquiries should be directed to the Office of Petitions staff at (703) 305-9282.

SUMMARY: The petition is **DENIED**.

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SM/DS; 3/6/01